

### **REMARKS/ARGUMENTS**

Reconsideration of this application, in view of the foregoing amendment and the following remarks and arguments, is respectfully requested.

Claims 1, 4, 12 and 23 are currently pending in this application. By the foregoing amendment new Claim 24 has been added to afford the applicants the breadth and scope of patent protection to which they are entitled. Accordingly, Claims 1, 4, 12, 23 and 24 are now present in this application for consideration and allowance.

Claims 1, 4, 12 and 23 currently stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent 6,248,110 to Reiley et al. This rejection is respectfully traversed for the following reasons.

In carrying out principles of applicants' invention, in accordance with a representatively illustrated embodiment thereof, a cavity is formed in cancellous bone by a method utilizing a specially configured tool which, as specified in Claim 1 and its dependent Claims 4, 12 and 23, comprises "a hollow body including a circumferential wall having a distal end, the tool also comprising an extension that protrudes from the circumferential wall, beyond the distal end and forms a platform that is open in at least one radial direction". By way of non-limiting example, the claimed hollow body may be the hollow body 210 of the insertion device 200 shown in the present applicants' FIGS. 2 and 7, the hollow body 210 having a distal end 250 from the circumferential wall of which a platform or extension 220 projects beyond the distal end 250, the platform 220 being open in at least one radial direction (representatively upwardly as viewed in FIG. 7).

To use the tool, an expandable structure is provided, and the tool and the expandable structure are introduced into a bone having an interior volume occupied, at least in part, by cancellous bone. As specified in Claims 1, 4, 12 and 23, the platform is positioned "near the expandable structure, with the platform located between the expandable structure and a first region of the cancellous bone which is not to be compressed" (see FIG. 2). A cavity is then formed in a second region of cancellous bone, as further specified in Claims 1, 4, 12 and 23, by "expanding the expandable structure from the distal end towards the platform with the platform

**serving as a barrier to induce the expandable structure to expand away from the platform in the at least one radial direction to compress the second region of the cancellous bone, while the first region of the cancellous bone remains substantially not compressed**". As can be seen in the present applicants' FIG. 2, the expanded member 310 compresses a region of the cancellous bone 71 to the left of the platform 220, but is blocked by the platform 220 from substantially compressing a region of the cancellous bone 71 to the right of the platform 220.

In characterizing Claims 1, 4, 12 and 23 as obvious in view of U.S. Patent 6,248,110 to Reiley et al, the Examiner refers to FIG. 5K(1) of Reiley and contends, on page 3 of the August 19, 2008 Office Action, that a left end portion of the illustrated catheter tube 50 (which contains the suction holes 88 in its outer wall) is a "**platform/extension**" that protrudes beyond the **distal end** (of the catheter tube 50) and is opened in at least one radial direction (presumably via the suction holes 88). The Examiner is thus contending that the "distal end" of the Reiley et al catheter tube 50 is closer to the proximal end of the catheter tube 50 than the longitudinal portion of the catheter tube 50 containing the suction holes 88. This contention by the Examiner is clearly incorrect, and is not supported by the disclosure in Reiley et al.

Specifically, in FIG. 4 of Reiley et al the distal end 54 of the catheter tube 50 is to the right of the suction holes 88, and has no extension or platform extending outwardly therefrom. As clearly shown in FIG. 4 of Reiley et al, **only the expandable member 56 extends outwardly beyond the distal end 54 of the catheter tube 50**. Despite this clear description and labeling in Reiley et al with respect to where the distal end of the catheter tube 50 is, the Examiner contends in effect that the distal end of the Reiley et al catheter tube 50 is to the **left** of the suction holes 88 (as viewed in FIG. 4 of Reiley et al).

Even if this contention by the Examiner was correct, Claims 1, 4, 12 and 23 would still not be obvious in view of Reiley et al since this reference fails to disclose or in any manner suggest another limitation in these claims - namely, the limitation that the recited cavity in a second region of cancellous bone is formed by "**expanding the expandable structure from the distal end towards the platform with the platform serving as a barrier to induce the expandable structure to expand away from the platform in the at least one radial direction to compress the second region of the cancellous bone, while the first region of the cancellous bone remains substantially not compressed**". As can clearly be seen in FIG. 4 of

Reiley, the longitudinal portion of the catheter tube 50 containing the suction holes 88 does not, and cannot, restrain expansion of the expandable member 56 in any radial direction. This is further confirmed in FIG. 5K(2) of Reiley et al which cross-sectionally illustrates the expandable member 56 actually being inflated (via the interior of the catheter tube 50) in cancellous bone 32 which is also shown in FIG. 5K(1) referred to by the Examiner. It is important to note in FIG. 5K(2) that, during the inflation of the expandable member 56, (1) the expandable member 56 does not contact an outer side surface of the illustrated distal end portion of the catheter tube 50, and (2) the expandable member 56 is not in any manner restrained by the catheter tube 50 against radial expansion relative thereto in any radial direction. Accordingly, the illustrated distal end portion of the Reiley et al catheter tube clearly does not function as an extension or platform which, as specified in applicants' Claims 1, 4, 12 and 23, induces the expandable structure "to expand away from the platform in the at least one radial direction to compress the second region of the cancellous bone, while the first region of the cancellous bone remains substantially not compressed".

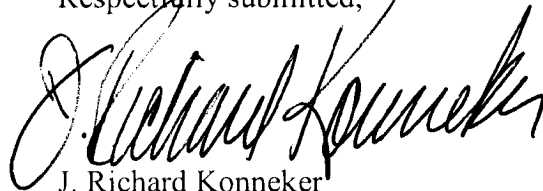
For at least the foregoing reasons it is respectfully submitted that none of applicants' Claims 1, 4, 12 and 23 is rendered obvious by U.S. Patent 6,248,110 to Reiley et al.

Newly presented Claim 24 is seen to be allowable via its dependency from allowable Claim 1, and also sets forth an additional limitation which is neither disclosed nor in any manner suggested in Reiley et al - namely, that the recited extension that protrudes from the circumferential wall of the hollow body beyond the distal end of the hollow body "protrudes from the distal end of the hollow body from only a circumferential portion of the circumferential wall of the hollow body". The longitudinal end portion of the Reiley et al expandable member 56 which the Examiner erroneously contends is an expansion deflection "extension" beyond the distal end of the member 56 clearly extends from the entire circumference of the circumferential wall of the adjacent longitudinal portion of the member 56. Newly presented Claim 24 is thus seen to be patentably distinguishable over U.S. Patent 6,248,110 to Reiley et al.

In view of the foregoing remarks and arguments, all of the claims currently pending in this application are seen to be in a condition for allowance. A Notice of Allowance of Claims 1, 4, 12, 23 and 24 is therefore earnestly solicited.

The Examiner is hereby requested to telephone the undersigned attorney of record at 972/739-8612 if such would further or expedite the prosecution of the instant application.

Respectfully submitted,



J. Richard Konneker  
Attorney for Applicants  
Registration No. 28,867

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Haynes and Boone, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 972/739-8612  
IP Facsimile: 214/200-0853  
Client Matter No. P0031752.01  
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Diane Sutton